

REMARKS

The above amendments and following remarks are submitted in response to the pending Official Action of the Examiner mailed March 8, 2007. Having addressed all objections and grounds of rejection, claims 1-21, being all the pending claims, are now deemed in condition for allowance. Entry of this amendment and reconsideration to that end is respectfully requested.

Claim 21 has been belatedly objected to in view of a missing period. In response thereto, claim 21 has been amended.

Claims 11-20 have been belatedly rejected under 35 U.S.C. 101 as not drawn to statutory subject matter. This ground of rejection is respectfully traversed for the following reasons.

Claim 11 is an independent apparatus claim having four "means-plus-function" limitations as specifically provided by statute and judicial law. It is clear that the Examiner disagrees, because MPEP 2131 states:

Where a claim limitation meets the 3-prong analysis and is being treated under 35 U.S.C. 11, sixth paragraph, **the examiner will include a statement in the Office action that the claim limitation is being treated under 35 U.S.C. 112, sixth paragraph.** (Emphasis added)

Because the Examiner has not made this statement as explicitly required by MPEP 2181 and has clearly not examined claim 11 in accordance with the requirements of MPEP 2181-2184, it is readily apparent that claim 11 has not been found to be a "means-plus-

function" claim. This finding is clearly erroneous and incorrect as a matter of law.

As a result, the Examiner has found that:

Claim 11 is directed to an apparatus consisting of software per se because no physical article is observed within the body of the claims.

This finding is incorrect as a matter of law. Thus, the rejection under 35 U.S.C. 101 as to claims 11-15 is respectfully traversed for failure of the Examiner to examine claims 11-15 in accordance with controlling law.

The rejection with regard to claim 16 is largely incoherent.

The Examiner states:

Claim 16 appears to be a data processing system nested with user steps making it unclear which elements must be present to meet the claim because the claim recites abstract elements and steps. (Emphasis added)

Claim 16 is an independent apparatus claim. As a matter of law, all "elements must be present to meet the claim".

The Examiner's attention is respectfully directed to MPEP 2106.01 which provides in part:

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. (Emphasis added)

The Examiner has already found that "the computer program is being claimed as part of an otherwise statutory manufacture or machine" (i.e., "a data processing system"). Therefore, MPEP 2106.01 mandates that "the claim remains statutory irrespective of the fact that a computer program is included in the claim".

To assist the Examiner in his analysis, claim 16 has been amended to move those elements from the preamble to the body of the claim.

Claims 1-21 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 2005/0192851, published in the name of Rangnekar (hereinafter referred to as "Rangnekar"). The ground of rejection is respectfully traversed for the following reasons.

The standards for a finding of anticipation during examination are specified in MPEP 2131, which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection is respectfully traversed because "the identical invention" is not shown by Rangnekar "in as complete detail as is contained in the claims" as is required by MPEP 2131.

Applicants' invention as disclosed and claimed provides a method and apparatus for requesting services from a legacy data base management system from a user terminal using standardized object-oriented command language which is incompatible with the legacy data base management system. This is accomplished by using the legacy data base management system to perform the required conversions using parameterized inputs defined in the incompatible standardized object-oriented command language.

For whatever reason, the Examiner has cited and sought to apply Rangnekar, which permits a customer to enter a booking query at an ATM. Thus, instead of a user performing data base functions using a data base management system via a user terminal as claimed, the user of the Rangnekar is limited to the minimal functions which can be performed by an ATM. To the extent that the Examiner cites conversions within Rangnekar, these amount to mere conversions of data string message formats within a web server rather than the claimed conversion of "user requests" within the same legacy data base management system as is used to actually honor the claimed service request. As a result of the lack of pertinence of this reference, the rejection of claims 1-21 can only be based upon clearly erroneous findings of fact and incorrect application of controlling law.

Even more troubling is that the Examiner has impermissibly attempted to be his own "lexicographer". As is explained in more

detail below, the Examiner has consistently ignored Applicants' definitions and those commonly utilized in the art, for definitions manufactured solely to enable application of Rangnekar to Applicants' claims.

Claim 1 has four basic elements. The first element is "a terminal which generates a user request in a standardized object-based command language for access to a data base". In making his rejection, the Examiner completely ignores the claimed element and cites an "automatic teller machine" of Rangnekar. As a matter of law, the Examiner is prohibited from his finding that the claimed element is "interpreted to include "ATM....End User" as alleged.

By way of definition, page 15, lines 11-13, Applicants' specification states:

The client interfaces with the system via Internet terminal 12. Preferably Internet terminal 12 is an industry compatible, personalized computer having a current version of the Windows operating system and suitable web browser, all being readily available commercial products.

It is inconceivable that this claimed element could be "interpreted to include ATM" as alleged. Because the ATM is not the claimed terminal, it cannot generate "a user request in a standardized object-based command language for access to a data base" as claimed. Therefore, the Examiner simply ignores these limitations.

The second claimed element is "a legacy data base management system responsively coupled to said terminal which honors said user request by execution of a non-standardized command language to produce a result from a dataset". In making his rejection, the Examiner apparently cites CRS 30 of Rangnekar. However, the Examiner ignores the remainder of the claim which requires the claimed "legacy data base management system" to be "responsively coupled to said terminal". Surely, the Examiner does not suggest that Rangnekar discloses that CRS 30 is somehow "responsively coupled to said terminal", as claimed. Furthermore, because Rangnekar says nothing of a "dataset" within the claim associated with CRS 30, Examiner simply ignores the claimed limitation. Finally, the claim requires that the "legacy data base management system" **honors** the claimed user request by execution of a non-standardized command language to produce a result from a dataset. Nowhere does Rangnekar suggest that CRS 30 meets these limitations. Therefore, the Examiner simply ignores them.

The third claimed element is "a conversion facility for conversion of said standardized object-based command language to said non-standardized command language". In making his rejection, the Examiner completely ignores the claimed limitations citing Figs. 18-19 and paragraphs 0118-0119. As if any of these citations have anything to do with the claimed

element or HTML, the Examiner impermissibly states "interpreted to included HTML".

The fourth claimed element is "a facility responsively coupled to said legacy data base management system which prepares said result for transfer to said terminal and which modifies said dataset **if and only if specified in said service request**".

Ignoring these limitations, the Examiner states:

....interpreted to include "XML document is updated at a financial service system server only if there is a change in the city data"....

The Examiner then cites five full paragraphs of Rangnekar which have nothing to do with the claimed invention. It is truly confusing why the Examiner would consider these citations related to claim 1.

As a result of Rangnekar having none of the four elements of claim 1, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and further limits the coupling of the claimed "terminal". Even though the Examiner found the "terminal" of claim 1 to be "interpreted to be an ATM", he finds the further limitations to the coupling to be in the totally unrelated paragraphs 11 and 71. The claim explicitly requires the claimed "terminal" to be coupled in the claimed fashion. Yet, the Examiner ignores Rangnekar, paragraph 0111, which begins:

As illustrated in FIG. 14, financial institutions run their ATM's 12 on their private networks.

Thus the Examiner's findings are incorrect as a matter of law.

The rejection of claim 2 is respectfully traversed.

Claim 3 depends from claim 2 and is further limited "wherein the user request specifies the dataset". To make his rejection, the Examiner arbitrarily cites paragraphs 8-9, which says nothing of the claimed limitation. There is no "dataset", no ATM, etc. Thus, the Examiner has impermissibly based his rejection on clearly erroneous findings of fact. The rejection of claim 3 is respectfully traversed.

Claim 4 depends from claim 3 and further limits the claimed coupling network. As explained above, Rangnekar does not meet the limitations of claim 3 from which claim 4 depends. Therefore, Rangnekar cannot meet the further limitations of claim 4. Therefore, the Examiner ignores the claimed invention and his previous findings to cite Rangnekar, paragraph 11. The rejection of claim 4 is respectfully traversed.

Claim 5 depends from claim 4 and further limits the claimed "standardized object-based command language". To make his rejection, the Examiner again ignores the claimed invention and simply seeks to find the words of the claim in disparate and unrelated portions of the prior art. He cites paragraph 107, which relates to software not found in CRS 30, or the ATM 12. The rejection of claim 5 is respectfully traversed.

Claim 6 is an independent method claim having five limiting steps. Rangnekar has none of these five steps. Apparently, the Examiner has not found the first step to be expressly disclosed by Rangnekar, so the Examiner states:

....interpreted to include "prints your itinerary....

This statement is clearly erroneous on its face. Furthermore, the statement does not address Applicants' claimed invention, so even if true, it is legally irrelevant. Therefore, the first element of claim 6 is admittedly not found in Rangnekar.

The second claimed element is "receiving said service request by said legacy data base management system". In making his rejection, the Examiner cites paragraph 0092, which concerns operation of a web server neither claimed by Applicants nor associated with the basic system having a "terminal" and a "legacy data base management system".

The third claimed element is "converting said service request in said standardized object-based command language into said non-standardized command language". In making his rejection, the Examiner states:

....interpreted to include "converted to a query that is understandable by CRS 30"....

In clearly erroneously finding the fourth element, the Examiner again admits that Rangnekar has no "legacy data base management system" which receives the claimed "service request" for conversion as required by claim element b.

The fifth claim element requires "modifying" a dataset. The Examiner cites paragraph 0150 which has nothing to do with this limitation. The rejection of claim 6, and all claims depending therefrom, is respectfully traversed.

Claim 7 depends from claim 6 and further limited by "wherein said dataset is specified by said service request". Instead of addressing the claimed limitation, the Examiner appears intent on showing the disclosure of a highlighted portion of Fig. 25. The rejection of claim 7 is respectfully traversed for failure to address the claimed invention.

Claim 8 depends from claim 7 and further limits the claimed coupling network. As explained above, Rangnekar does not meet the limitations of claim 7 from which claim 8 depends. Therefore, Rangnekar cannot meet the further limitations of claim 8. And again, the Examiner ignores the first sentence of paragraph 0111 which shows that even if ATM 12 did generate the claimed "service request", it is expressly coupled to a "private network". The rejection of claim 8 is respectfully traversed.

Claim 9 depends from claim 8 and further limits the claimed coupling network. As explained above, Rangnekar explicitly discloses coupling only via a "private network" (see paragraph 0111). The rejection of claim 9 is respectfully traversed.

Claim 10 depends from claim 9 and further limits the claimed "standardized object-based command language". To make his

rejection, the Examiner has again made a finding completely unsupported by the prior art of record. The rejection of claim 10 is respectfully traversed.

Claim 11 is an independent apparatus claim having five "means-plus-function" limitations. Nevertheless as explained above, the Examiner ignores his obligations under MPEP 2181-2184. He simply states that Rangnekar meets the claimed elements without support from the prior art of record. Thus, the rejection of claim 11 is respectfully traversed for absence of examination in accordance with controlling law.

Claim 12 depends from claim 11 and is further limited by the claimed service request specifying the claimed dataset. In making his rejection, the Examiner cites Fig. 22 of Rangnekar which has nothing to do with the claimed "service request" or the claimed "dataset". The rejection of claim 12 is respectfully traversed.

Claim 13 depends from claim 12 and is further limited by the claimed "means located within said permitting means for generating a second service request". Having not found the claimed "permitting means" in his rejection of claim 11, the Examiner somehow finds that the claimed limitations can somehow be found in Figs. 22-23. This finding is unsupported by the prior art and is therefore clearly erroneous. The rejection of claim 13 is respectfully traversed.

Claim 14 depends from claim 13 and further limits the claimed "offering means". Because Rangnekar does not have the claimed "offering means", it cannot have these further limitations. Therefore, the Examiner simply makes the unsupported statement that Rangnekar somehow contains these limitations. The rejection of claim 14 is respectfully traversed.

Claim 15 depends from claim 14 and further limits the claimed "permitting means". Because Rangnekar does not have the claimed "permitting means" as explained above, it cannot have these further limitations. Therefore, the Examiner expressly admits that claim 15 is not anticipated by Rangnekar, even though he has maintained his rejection. The rejection of claim 15 is respectfully traversed as admittedly not anticipated by Rangnekar.

Claim 16, as amended, has had the limitations of the rather extensive preamble moved into the body of the claim. These limitations provide the basic environment of the invention, along with two key limiting elements. Rangnekar does not have these environmental limitations for the reasons discussed above. Thus, the Examiner simply finds these limitations without support from the prior art of record.

The third claimed element is the "conversion facility". Because Rangnekar does not have this element, the Examiner cites

unrelated paragraph 0270. Apparently, for some reason, the Examiner appears to assume that "Perl using COM" is somehow related to the claimed "conversion facility". In addition to these findings being unrelated to the claimed invention, this finding is clearly erroneous.

The fourth claimed element is the "facility which modifies" the claimed "dataset". In making his rejection, the Examiner cites paragraph 0220 stating:

"Cancelled (sic) means that this transaction was cancelled (sic) upon the customer's request".

It is unknown why the Examiner considers this relevant to the claimed element. Perhaps the Examiner equates the claimed "modifies" with the disclosed "canceled". If so, this is also logically inconsistent.

Therefore, the rejection of amended claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 17 depends from claim 16 and is further limited by "wherein said dataset is specified by said service request". Apparently, the Examiner has found this within Rangnekar completely without support from the reference. The rejection of claim 17 is respectfully traversed.

Claim 18 depends from claim 17 and further limits the claimed coupling network. Because Rangnekar cannot meet the limitations of claim 17 from which claim 18 depends, it cannot meet the further limitations of claim 18. Therefore, the

Examiner cites a "disembodied" reference to "Internet" 12 at Fig. 2, which is clearly not coupled to ATM 12 (see paragraph 0111 in addition to Fig. 2). The rejection of claim 18 is respectfully traversed.

Claim 19 depends from claim 18 and further limits the claimed coupling network. Because Rangnekar cannot meet the limitations of claim 18 from which claim 19 depends, it cannot meet the further limitations of claim 19. The rejection of claim 19 is respectfully traversed.

Claim 20 depends from claim 19 and further limits the claimed standardized command language. Because Rangnekar cannot meet the limitations of claim 19 from which claim 20 depends, it cannot meet the further limitations of claim 20. The rejection of claim 20 is respectfully traversed.

In rejecting claim 21, the Examiner makes many of the same errors discussed above. In addition, the Examiner makes additional errors. For example, in finding the claimed "terminal which generates a user request in a standardized object-based command language which specifies access to a dataset within a data base", the Examiner makes much of the ".pl" in the Window bar of Figs. 16-17. It is unknown why the Examiner finds that this shows the claimed "terminal which generates a user request....".

Similarly, the second claimed element is a "legacy data base management system...." and the Examiner cites Fig. 12 showing an ATM. The Examiner further mentions Phone Agents 2-5 and "travel desk" of Fig. 5B.

The third claimed element is a "conversion facility". For whatever reason, the Examiner makes citations to references which are clearly not prior art.

The fourth claimed element is a "facility". In making his rejection, the Examiner cites four unrelated paragraphs from Rangnekar. The rejection of amended claim 21 is respectfully traversed.

Claims 1, 6, 11, 16, and 21 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting. This matter will be dealt with when ripe.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-21 being the only pending claims.

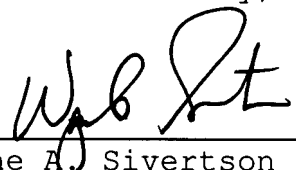
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Respectfully submitted,

Barbara A. Christensen et al.

By their attorney,

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Wayne A. Sivertson
Reg. No. 25,645
Suite 401
Broadway Place East
3433 Broadway Street N.E.
Minneapolis, MN 55413
(612) 331-1464